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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/783,774	02/15/2001	Robert A. Vito	10332-1RE	2262

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AKIN, GUMP, STRAUSS, HAUER & FELD, L.L.P.  
ONE COMMERCE SQUARE, SUITE 2200  
2005 MARKET STREET  
PHILADELPHIA, PA 19103

EXAMINER

BARRETT, SUZANNE LALE DINO

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 12/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/783,774

Applicant(s)

VITO, ROBERT A.

Examiner

Suzanne Dino Barrett

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 07 February 2002 and 17 July 2002.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-7 and 9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7 and 9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Reissue Applications***

1. While there is concurrent litigation related to this reissue application, action in this reissue application will NOT be stayed because of applicant's request that the application be examined at this time. Due to the related litigation status of this reissue application, EXTENSIONS OF TIME UNDER THE PROVISIONS OF 37 CFR 1.136(a) WILL NOT BE PERMITTED.

2. The reissue oath/declaration filed with this application is defective because it fails to contain the statement required under 37 CFR 1.175(a)(1) as to applicant's belief that the original patent is wholly or partly inoperative or invalid by reason of the patentee claiming more (or less) than the patentee had a right to claim in the patent. See 37 CFR 1.175(a)(1) and see MPEP § 1414.

3. The reissue oath/declaration filed with this application is defective because it fails to identify at least one broadening error which is relied upon to support the reissue application. See 37 CFR 1.175(a)(1) and MPEP § 1414.

4. The reissue oath/declaration filed with this application is defective (see 37 CFR 1.175 and MPEP § 1414) because of the following: it fails to specify at least one example of a broadening of the claims as the error.

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5. Claims 1-7,9 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251 as set forth above. See 37 CFR 1.175.

The nature of the defect(s) in the declaration is set forth in the discussion above in this Office action.

6. In accordance with 37 CFR 1.175(b)(1), a supplemental reissue oath/declaration under 37 CFR 1.175(b)(1) must be received before this reissue application can be allowed.

Claims 1-7,9 are rejected as being based upon a defective reissue declaration under 35 U.S.C. 251. See 37 CFR 1.175. The nature of the defect is set forth above.

Receipt of an appropriate supplemental oath/declaration under 37 CFR 1.175(b)(1) will overcome this rejection under 35 U.S.C. 251. An example of acceptable language to be used in the supplemental oath/declaration is as follows:

"Every error in the patent which was corrected in the present reissue application, and is not covered by a prior oath/declaration submitted in this application, arose without any deceptive intention on the part of the applicant."

Applicant should note that the supplemental declaration is needed to cover the amendments filed during the reissue proceedings.

7. The original patent, or a statement as to loss or inaccessibility of the original patent, must be received before this reissue application can be allowed. See 37 CFR 1.178.

***Drawings***

8. The proposed drawing correction filed on 2/15/01 has been approved in terms of content, however, the amended drawing figures must be labeled as "AMENDED" in red on the drawing corrections. This has been done by the Examiner on the proposed drawings filed 2/15/01, however, when formal drawings are prepared, Applicant should note that this correction must be made on each amended figure. See MPEP § 608.02(v).

***Specification***

9. Applicant should note that the Title page was not included with the original filing of this reissue application. In order to expedite matters, the Examiner has put a copy of the Title page in the file and made the substitution of the new Abstract presented in the amendment of 2/15/01. The Examiner has also made the assignment correction to the Title page, pursuant the Certificate of Correction, which should be incorporated as part of the original patent.

***Response to Amendment***

10. Applicant has failed to comply with 37 CFR 1.173 in presenting proper reissue amendments. No "clean copy" should be presented as required by 37 CFR 1.121. Thus the clean copy of the amendment 2/7/02 should be removed from the file. Applicant should submit a supplemental amendment which would supercede the improper amendments. 37 CRF 1.173 states that 1) all amendments in a reissue application

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must be made with regard to the original patent, and 2) any amendment to the language of the original patent must be accounted for by the use of brackets (deletions) and underlining (insertions).

For example, Applicant is referred to the amendment of paper no. 11 (amendment of 2/7/02). In reviewing the marked up version of the claims amended in paper no. 11, it appears that Applicant's brackets and underlining were inserted to distinguish amendments made with respect to the claims as amended previously, and not with respect to the patented claims. Claims 1 and 9 have been reviewed extensively and are illustrative of this point. It is noted that claim 9, as a new claim relative to the patent, should be totally underlined. Also with respect to "new" claims, deletions from a "new" claim should not be bracketed. Instead, deleted language merely disappears to be replaced by new language. However, the "new" claim remains totally underlined. Applicant must resubmit this amendment in proper form and should review all other amendments accordingly.

11. Claims 1-7,9 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

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In view of the fact that the amendment of 2/7/02 is in improper form and has not been entered, the previous rejection of claim 1-7,9 set forth in the office action of paper no. 10, mailed 1/25/02, still stands. Applicant is referred to that office action, paragraph 1.

***Information Disclosure Statement***

12. The information disclosure statement (IDS) submitted on 7/17/02 is being considered by the examiner. However, since the references were not listed on a PTO-1449, they will be listed on a PTO-892, except for the French 2,719,005 reference which appears on the PTO-1449 previously submitted on 4/23/01.

***Allowable Subject Matter***

13. Claims 1-7,9 are allowed.

14. As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

***Response to Arguments***

15. Applicant's arguments with respect to claims 1-7,9 have been considered but are moot in view of the new ground(s) of rejection.

As set forth above, there are several outstanding formal matters which must be addressed. Furthermore, while the claims presented in the amendment of 2/7/02 would

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obviate the recapture rejection and define over the prior art of record, they are in improper amended form and so, have not been properly entered. Therefore, the rejection under 35 U.S.C. 112 still stands. In addition, the defective declaration necessitates a rejection of the claims under 35 U.S.C. 251. Accordingly, claims 1-7,9 stand rejected.

### ***Conclusion***

16. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Suzanne Dino Barrett whose telephone number is 703-308-0825. The examiner can normally be reached on M-Th 8:30-7:00.



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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Knight can be reached on 703-308-3179. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1020.



Suzanne Dino Barrett  
Primary Examiner  
Art Unit 3676

sdb  
November 26, 2002